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EXAMINER

DESIR, PIERRE LOUIS

ART UNIT

PAPER NUMBER

2617

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11/15/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/717,892	Applicant(s) KOCH ET AL.	
	Examiner PIERRE-LOUIS DESIR	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 09/01/2010 have been fully considered but they are not persuasive.

Applicants argue that Griffith's, the cited reference, service control point translates a server address in the packet switching SS7 network, not a "virtual telephone number."

Examiner respectfully disagrees.

First, it should be noted that broadly written claims are broadly interpreted by examiner. In this present case, the independent claims disclose "virtual telephone number." The specification does not provide of what constitutes a "virtual telephone number." Is the virtual telephone number a regular telephone number? The specification does not answer that question. A virtual telephone number is being interpreted as any address or telephone number, which includes a server address. In the remarks, it can be seen that applicants' arguments does not answer that question nor does it show the difference between the server address and the claimed "virtual telephone number." In the claims' language, a dialed number is routed to a virtual telephone number. In Griffiths, a dialed number is translated into a SCP address which would provide the advanced service.

New claim 21 describes a memory storing software, which is directed to non-statutory subject matter. Rejection regarding "computer program product" was addressed in the office action mailed on 01/28/2008, which resulted in applicants cancelling the associated claim. The same rejection would be applied for newly claim 21.

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Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In particular, regarding “Subject Matter Eligibility of Computer Readable Media,” The Official Gazette (O.G.) of January 26, 2010, states:

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). **The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter** (emphasis added). See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach.

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim.

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Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal per se is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 discloses a “memory storing software”. This recitation was not described in the specification. As such, the recitation constitutes new matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Griffiths, US 20020186827 A1.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 11 and 21, Griffiths discloses a system and method for monitoring communications usage, comprising receiving a call routed from a dialed number in a native transport network to a virtual telephone number in a service-providing network, the call routed from a native transport network to a virtual telephone number in the service providing network, the native transport network having limited or no capability of providing advanced telephony service (i.e., when a caller using telephone 131 places a call to a subscriber using a cellular phone 220, and SSP sends an Advanced Intelligent Network (AIN) query to SCP via an SS7 network (see paragraph 53). In paragraphs 113-114, it is disclosed that an AIN query begins with

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a TCAP query message that is sent via a TM subsystem within the SSP to the SCP by way of an STP and the SS7 control network. The STP receives the TCAP query message, and then translates the subscriber's address to determine the correct SCP address (i.e., virtual telephone number) and the appropriate service package application for processing the AIN service request (paragraphs 113-114). Thus, a call from a dialed number is routed to a virtual telephone number in a service-providing network, wherein the native network, i.e., the network where the call came from cannot provide the AIN service); providing the advanced telephony service to the call, wherein the virtual telephone number utilizes the intelligent services provided by the service-providing network (i.e., the SCP creates a routing key from the TCAP message and passes the routing key information along to the CAS SPA, which uses the routing key to identify the subscriber of the call administration service) (see paragraph 114); routing said call from the service-providing network to a terminating network destination (i.e., routing the incoming call to the subscriber voice mail subsystem (see paragraph 21. Also refer to paragraph 125); and monitoring a duration of said call traversing the service-providing network (i.e., duration of each telephone call made) (see paragraph 70).

Regarding claims 2 and 12, Griffiths disclose a system and method (see claims 1 and 11) further comprising monitoring a status of said call (i.e., monitoring for billing) (see paragraph 70).

Regarding claims 3 and 13, Griffiths disclose a system and method (see claims 1 and 11 rejection) further comprising routing said call to an original destination via the native transport network (i.e., routing an incoming call may terminate the incoming call to the subscriber (i.e., original destination)) (see paragraph 21).

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Regarding claims 5 and 17, Griffiths discloses a system and method (see claims 1 and 11 rejections) wherein said service-providing network is a network selected from the group consisting of a wireline network, a wireless network, and a packet-switching network (see paragraphs 53, 107-108).

Regarding claims 6 and 14, Griffiths discloses a system and method (see claims 1 and 11 rejections) further operative to associate the virtual telephone number to another telephone number existing in the native transport network (i.e., translates the subscriber's address to determine the correct SCP's address) (see paragraph 114).

Regarding claims 7 and 15, Griffiths discloses a system and method (see claims 1 and 11 rejections) further comprising associating the virtual telephone number (i.e., SCP address) to another telephone number/packet voice-based telephone number (i.e., phone number or device's network address) existing in the native transport network (see paragraphs 97 and 114).

Regarding claim 8, Griffiths discloses a method (see claims 1 and 11 rejections) wherein said native transport network is a network selected from the group consisting of a wireline network, and a packet-switching network (see paragraphs 53, 107-108).

Regarding claim 9, Griffiths discloses a method comprising billing a telecommunication subscriber of a native transport network for the monitoring (i.e., billing) (see paragraphs 70 and 109).

Regarding claim 10, Griffiths discloses a method (see claim 1 rejection) further comprising billing a subscriber based on said duration of said call (see paragraph 70).

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Regarding claim 16, Griffiths discloses a system (see claim 11 rejection) wherein said service-providing network comprises an advanced Intelligent network (i.e., AIN) (see paragraph 114).

Regarding claims 18-19, Griffiths discloses a system (see claim 11 rejection) wherein the service-providing network modifies messages accompanying the call so that the call is not routed back to the service providing network in an endless loop, and wherein the service providing network modifies caller information associated with call (i.e., the STP receives the TCAP query message, and then translates the subscriber' address to determine the correct SCP address. The STP reformulates and forwards the TCAP message to the appropriate SCP, wherein the SCP creates a routing key from the TCAP message and passes the routing key information along to the CAS SPA, wherein the CAS SPA uses the routing key to identify the subscriber of the call administration service (paragraph 114). The call is not routed back to the service-providing network in an endless loop because the call is properly routed/forwarded using the routing key information).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PIERRE-LOUIS DESIR whose telephone number is (571)272-7799. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571)272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PIERRE-LOUIS DESIR/
Examiner, Art Unit 2617